

ESTTA Tracking number: **ESTTA760541**

Filing date: **07/26/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92061215
Party	Plaintiff Schiedmayer Celesta GMBH
Correspondence Address	MICHAEL J STRIKER STRIKER STRIKER & STENBY 103 EAST NECK RD HUNTINGTON, NY 11743 UNITED STATES striker@strikerlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Michael J. Striker
Filer's e-mail	striker@strikerlaw.com
Signature	/Michael J. Striker/
Date	07/26/2016
Attachments	SKMBT_42116072613280.pdf(415549 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL & APPEAL BOARD**

Schiedmayer Celesta GmbH,	)	
	)	
Petitioner,	)	
	)	
v	)	Cancellation No. 92/061,215
	)	Reg. No. 3,340,759
Piano Factory Group, Inc.,	)	Mark: SCHIEDMAYER
	)	Registration Date: 11/20/2007
Respondent.	)	
_____	)	

**PETITIONER'S MEMORANDUM IN OPPOSITION TO RESPONDENT'S PETITION TO  
DISQUALIFY PETITIONER'S COUNSEL MICHAEL J. STRIKER OF STRIKER,  
STRIKER & STENBY**

Respondent, Piano Factory Group, Inc. (Respondent) has moved to disqualify Michael J. Striker (herewith referred to as "Striker" or as the "undersigned") from serving as counsel for Petitioner, Schiedmayer Celesta GmbH.

Petitioner herewith responds to the Motion to Disqualify Michael J. Striker as follows:

**PREAMBLE**

On July 22, 2016 Petitioner filed a Motion for Summary Judgement based upon the fact that at all times relevant hereto, Respondent, Piano Factory Group, Inc. was and is a suspended corporation not entitled to do business of any kind.

Accordingly, Respondent's Motion to Disqualify should be given no consideration, as it is being filed by a suspended entity not entitled to defend itself and not entitled to do business.

Nevertheless, Petitioner sets forth below the reasons why Respondent's Motion to Disqualify is in any event frivolous and without merit:

### FACTS

The pertinent facts are the following:

On April 17, 2015, Schiedmayer Celesta GmbH, the Petitioner herein, caused to be filed U.S. Trademark Application Serial No. 86/600,864 for the mark SCHIEDMAYER. The application was filed in the name of the Applicant, Schiedmayer Celesta GmbH. Striker was and is the attorney of record. The subject trademark application alleged a date of first use of 1860.

In an Office Action dated July 14, 2015, the Examiner refused registration in view of existing registration No. 3,340,759 owned by Piano Factory Group, Inc., also for the mark SCHIEDMAYER. The Examiner then suspended prosecution.

Thereafter, Schiedmayer Celesta GmbH, caused to be filed the subject Petition for Cancellation, No. 92/061,215, which seeks to cancel the conflicting

trademark registration No. 3,340,759. Striker was and is acting as attorney for Petitioner.

At all times Striker has acted only as Attorney for Schiedmayer Celesta GmbH. Striker has no independent knowledge whatsoever of any facts relating to this proceeding. Any such facts are within the knowledge of Elliane Schiedmayer, President of the Petitioner.

Respondent now seeks to disqualify Striker as counsel for Schiedmayer Celesta GmbH with respect to Cancellation No. 92/061,215.

#### SUMMARY OF RESPONDENT'S ARGUMENT

It is frankly difficult to clearly comprehend exactly what position Respondent is taking.

Stripped of its verbiage, Respondent appears to argue as follows:

Striker caused to be filed as attorney for Schiedmayer Celesta GmbH, Trademark Serial No. 86/600,864. The said trademark application alleges a date of first use of 1860.

Ergo, Striker, having filed the subject trademark application as attorney for Schiedmayer Celesta GmbH, has some knowledge as to the allegation of a first use date of 1860.

For unexplained reasons, Respondent also refers to a trademark application filed by a totally different justice entity, some 32 years ago, claiming a first use date of 1960. Striker has never had anything whatsoever to do with the application filed 32 years ago.

As best understood, Respondent appears to argue that Striker, having signed Trademark Application Serial Number 86/600,864 (which is not even involved in this Petition for Cancellation), somehow has become a necessary witness, and should therefore be disqualified.

#### ARGUMENT

It is believed that Respondent's Motion is governed by Section 11.307(a) of the USPTO Rules of Professional Conduct, 37 CFR 11.307(a). This section sets for the following:

- (a) A practitioner shall not act as advocate at a proceeding before a Tribunal in which a practitioner is likely to be a necessary witness unless:
  - 1. Testimony relates to an uncontested issue;
  - 2. The testimony relates to the nature and value of legal services rendered in the case; or
  - 3. Disqualification of the practitioner would work substantial hardship on the client.

By way of background, it is noted that in determining whether or not disqualification is required, the first consideration is whether the attorney is a necessary witness, and second is, if necessary, does that attorney meet a listed exception. See: *INTS It is Not The Same GmbH v Disidual Clothing, LLC*, Opposition No. 91212768 (March 28, 2015).

An attorney will be considered a necessary witness where no other person is available to testify in his place. See: *Northbrook Digital, LLC v Vendio Servs., Inc.*, 625 F. Supp. 2d 728,765 (D. Minn. 2008).

A necessary witness is one who offers evidence that is not available from another source. See: *Horaist v. Doctors Hosp. of Opelousas*, 255 F. 3d 261, 267 (5<sup>th</sup> Cir. 2001).

#### An Attorney May Sign Verifications on Behalf of an Applicant or Registrant

Respondent appears to be laboring under the patently incorrect assumption that because Striker signed the trademark application alleging a date of first use of 1860, that for some reason this makes Striker a witness in connection with the Petition for Cancellation.

An excellent summary on this subject may be found in the decision of Judge Cheryl Butler, Senior Counsel, Trademark Trial and Appeal Board, at *INTS It is*

*Not The Same GmbH v Disidual Clothing, LLC*, Opposition No. 91212768 (March 28, 2015).

For convenience, it is paraphrased below:

“The USPTO clearly permits an attorney to sign the verification (e.g., a Declaration) in support of an application, and other specified filings, on behalf of the applicant. Indeed, it is common for attorneys to do so. **The mere signing of the Declaration does not make an attorney a necessary witness...**

While Mr. Egbert [Striker] signed the aforementioned documents on behalf of his client, he has not created a circumstance where he alone would need to testify to the contents of those documents...Mr. Egbert [Striker] was merely a permitted signatory...thus, Mr. Egbert [Striker] is not a necessary witness.” *INTS It is Not The Same GmbH v Disidual Clothing, LLC*, Opposition No. 91212768 (March 28, 2015).” (Emphasis supplied)

Evidence as to First Use is Readily Available to Respondent

Respondent admits at the bottom of page 5 of its Motion that Striker is not a necessary witness:

“This is particularly so since the only person indicated in Petitioner’s Response to Interrogatory 38 other than Mr. Striker as having personal knowledge of the facts is Ellianne Schiedmayer, a national of Germany. If Respondent is permitted under the laws of Germany to depose her at all, it will only be by written questions under the procedure in TBMP Section 404.03(b)...[If Striker were to testify]...it would speed the discovery process, avoid issues caused by language barriers, and enable Respondent to adequately prepare its defense in this case.”

- Respondent’s Motion, page 5

Put another way, and somewhat more bluntly, Respondent is simply too lazy to utilize the well-known and perfectly adequate provisions of TBMP Section 404 relating to the deposing on written questions of a foreign national.

Not only is Striker not a necessary witness; Striker is not an appropriate witness. A witness is easily available to Respondent, namely, Elliane Schiedmayer. It is again emphasized that Striker has no independent knowledge whatsoever as to facts and at all times was merely acting as Attorney for the Applicant/Petitioner.

#### RESPONDENT'S COUNSEL IS ENGAGING IN ABUSIVE TACTICS

Respondent's counsel, Adam R. Stephenson, is engaging in abusive litigation tactics through the filing of this plainly frivolous, nonsensical and demeaning Motion to Disqualify.

If an attorney were to be disqualified because s/he signed a new trademark application, every attorney ever filing a legal document would be disqualified from further prosecution. The result is absurd.

Indeed, Stephenson even admits that the person who does have relevant information, Ellianne Schiedmayer, resides in Germany. Stephenson is simply too lazy to utilize the generally accepted discovery procedures relating to written questions in order to obtain information which Stephenson considers germane.



To ignore seeking testimony from a witness who does have knowledge and in the alternative to seek to disqualify counsel who has absolutely no knowledge, represents nothing less than abusive litigation tactics:

“...as one might expect, Rule 3.7 can encourage abusive litigation tactics where opportunistic parties file disqualification motions to interfere with the opposing sides choice of counsel.” See e.g. *Kalmanovitz v. G. Heileman Brewing Co.*, 610 F. Supp. 1319 (D. Del. 1985) (Motions to Disqualify are often disguised attempts to divest opposing parties of their counsel of choice).”

- Disqualification of Opposing Counsel, American Bar Association, Section of Labor and Employment Law Committee on Ethics and Professional Responsibility, 2010 Mid-Winter Meeting.

“Restrictions on a parties right to select representation by a particular attorney should be carefully scrutinized because disqualification can be used as a tactic to stall and derail the proceedings, redounding to the strategic advantage of one party over another.”

- Commercial Division Blog, Current Developments in Commercial Divisions of New York State Courts, April 11, 2015.

“Very often, applications to disqualify counsel are merely a dilatory tactic. This tactic has been addressed by numerous courts who have recognized that disqualification ‘may’ not be invoked merely to aid as a tool in litigation, sought to gain for one party of the other some advantage unrelated to the merits of the action...a going ploy in the courts is the attempt to disqualify your legal opponent.”

- Disqualification of Counsel in New York, Clausen Miller, September 2003.

“Because disqualification motions have a potential for abuse as litigation tactics, disqualification is viewed by Courts as a

'drastic measure' to be imposed only when absolutely necessary." (Citing authorities).

- *Lanness K. McKee v. Huntington James, et al.*, State of North Carolina Superior Court Division, 09 CVS 3031, July 2012.

### SUMMARY

Petitioner again refers the Board to its currently pending Motion for Summary Judgement filed July 22, 2016. In that Motion it is made clear that Respondent is a suspended Corporation not entitled to defend itself in a Court proceeding and not entitled to do business of any kind.

Accordingly, the Respondent's Motion to Disqualify should be dismissed on this basis alone.

In any event the Motion to Disqualify is at best frivolous and at worst interposed for dilatory purposes. It should be forthwith dismissed.

Respectfully submitted,



Michael J. Striker  
Attorney for Petitioner  
Reg. No.: 27233  
103 East Neck Road  
Huntington, New York 11743

CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the attached Memorandum in Opposition was served upon counsel for the Respondent:

Adam R. Stephenson, LTD  
40 w. Baseline Rd. Ste. 101  
Tempe, AZ 85283

Via First Class Mail, this 26<sup>th</sup> day of July, 2016

--



Michael J. Striker